

### **REMARKS**

Claims 1-15 and 21-25 were pending and rejected. In this response, Applicants have amended claims 1-15 and 21-25. Claim 16 was previously cancelled, and claims 17-20 are cancelled without prejudice herein. Therefore, claims 1-15 and 21-25 are currently pending. All amendments are fully supported by the disclosure and no new matter has been added. Applicants respectfully request reconsideration and allowance in light of the amendments to the claims and the following remarks.

### **Double Patenting**

In the Action, claims 1-15 and 21-25 were provisionally rejected for nonstatutory obviousness-type double patenting over claims 1-14 of copending Application No. 10/552873, and rejected for nonstatutory obviousness-type double patenting over claims 1-22 of U.S. Patent No. 7,490,641.

Applicants attach to this communication terminal disclaimers under 37 C.F.R. § 1.321(c) for copending Application No. 10/552873 and for U.S. Patent No. 7,490,641. Applicants respectfully submit that the terminal disclaimers obviate the double patenting rejections.

### **Objections to the Specification**

The amendment filed July 20, 2009 was objected to under 35 U.S.C. 132(a) on the grounds that it introduced new matter into the disclosure by amending claims 1 and 24 to recite "processing machine." The Examiner noted that the original disclosure supports structure including a planer, planer-matcher, or moulder. Applicants note that the disclosure further supports an optimizing planer (see e.g. Figures 29-32 and page 33, lines 9-16 of the specification).

Amendments to an application which are supported by the original description are not new matter (see e.g. MPEP 2163.07). As discussed below, the term "processing machine" is supported by the original disclosure. Thus, the term

"processing machine" does not introduce new matter, and Applicants respectfully request that the objection be withdrawn.

**Claim Rejections – 35 U.S.C. §112, First Paragraph**

Claims 1-15 and 21-25 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with both the written description requirement and the enablement requirement. Specifically, the Office Action cited a lack of support in the original disclosure for "a processing machine."

First, Applicants note that the preambles of claims 1 and 24 are not limiting. "If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, *and the preamble merely states, for example, the purpose or intended use of the invention*, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999), MPEP 2111.02. Claim 1 recites in the preamble "an infeed system for feeding an array of workpieces linearly downstream to a processing machine, the infeed system comprising . . . ." Applicants respectfully submit that the preambles of claims 1 and 24 merely recite the purpose or intended use of the invention and are therefore not limiting.

The subject matter of the claim need not be described using the same terms in order for the disclosure to satisfy the description requirement (see e.g. MPEP 2163.02). Further, "not everything necessary to practice the invention need be disclosed. In fact, what is well-known is best omitted." *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991), MPEP 2164.08. The specification must teach those skilled in the art how to make and use the full scope of the claimed invention "without 'undue experimentation'." *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993), MPEP 2164.08.

"Processing machine" is fully supported in the original disclosure because Applicants disclose several machines "widely used . . . to turn rough workpieces into

finished workpieces such as surfaced lumber and contoured shapes like molding, flooring and siding” (pg. 1, lines 11-13). While the Examiner asserts that processing machines in the woodworking art may be planers, jointers, or other various machines, Applicants respectfully submit that such machines are well known in the art. Therefore, the disclosure of every possible “processing machine” is not required. A person having ordinary skill in the art would be enabled by the Applicants’ disclosure to make and use the entire scope of the claimed invention without undue experimentation.

For at least these reasons, claims 1-15 and 21-25 comply with the written description requirement. Reconsideration of these rejections is respectfully requested.

#### **Claim Rejections – 35 U.S.C. §112, Second Paragraph**

Claims 1-15 and 21-25 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

In response, Applicants have amended the claim language specified in the rejections under this paragraph to overcome all rejections under 35 U.S.C. 112, second paragraph. Therefore, Applicants respectfully request that the rejections be withdrawn.

For at least the above reasons, Applicants respectfully submit that all currently pending claims are allowable as amended. Notice of Allowance is therefore requested. The Examiner is kindly invited to contact the undersigned with any questions or for further discussion of the application.

#### **CONCLUSION**

In view of the foregoing, Applicants submit that all pending claims are in condition for allowance. Should any questions arise, the Examiner is invited to contact the

undersigned at (206) 407-1569. Also, the Commissioner is hereby authorized to charge shortages or credit overpayments to Deposit Account No. 500393.

Respectfully submitted,  
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